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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,900	04/10/2001	Michitaka Ozono	024201-00001	7201

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Examiner

Applicant(s)

Art Unit

09/828900

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/28/00
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This action is issued in reply to applicant's Amendment A(Paper #3) filed 12/24/03.
2. All independent claims were amended.
3. Claims 1-11 as particularly amended, are pending.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 USC 103(a) as unpatentable over Dubner(US Pat. No:6.564,190) in view of Michaud(US Pat. No:6,003,018) and further in view of Sanders(US Pat. No: 6,411,936)

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6. As per claims 1-11 Dubner teaches a rule-based decision process for formulating an investment strategy in debt and equity with a variety of businesses(Abstract)(Figs 1-5)(col 1 line 45-col 2 line 40) as well as analyzing market research data in terms of risk and return and determining trends(Fig 1/110) and graphically represents the values on a risk return matrix(Fig 1)(Fig 2).In addition to that taught by Dubner, Michaud also teaches graphical representations of risk/return in coordinate systems with trends and value changes(Fig 3) as well as a composition diagram in rectilinear form for debt/equity

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compositions for both short and long term over the horizon(Fig 4) and a graphical depiction of reward and risk(Fig 5) with trends in value(Fig 5) to form a risk/reward decision rule matrix(col 3 lines 54-56).Michaud teaches a method of evaluating an existing portfolio consisting of a plurality of assets which may be a projects in a business, etc(Abstracts)(col 1 line 15-col 21 line 25)(col 3 line 39-col 4 line 8).Michaud also teaches use of a different storage capabilities in implementation(col 6 lines 17-52). In addition to that taught by Michaud, Sanders teaches an enterprise value enhancement method(col 2 line 16-col 3 line 38) including a business model with results,model,design on mutually orthogonal axes(Fig 4).Sanders further teaches performance, creativity, leadership, strategy as part of the business design(Fig 4) as well as knowledge generation, organization and communication as part of implementation(Fig 4).Sanders also teaches metrics of revenue growth, R&D growth, market value growth(Fig 5/521) in performance(Fig 5).Sanders also teaches a value enhancement processing system(Fig 10) as well as a performance metrics engine(Fig 11/106) and a value enhancement solution generator(Fig 11/102). It would have been obvious to one skilled in the art at the time of the invention to combine Dubner in view of Michaid and further in view of Sanders to teach the applicant's disclosure. The motivation to combine is to teach a business strategy for minimizing the instability of solutions as enunciated by Michaud(col 2 lines 9-11). The further motivation to combine Dubner in view of Michaid and further in view of Sanders is to teach a system for enterprise value analysis as enumerated by Sanders(col 6 lines 28-44).

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 11 is further rejected under 325 USC 101 for failing to provide a concrete, useful and tangible output.

***Response to Arguments***

9. Applicant's arguments are moot in view of the additional grounds of rejection.

***Conclusion***

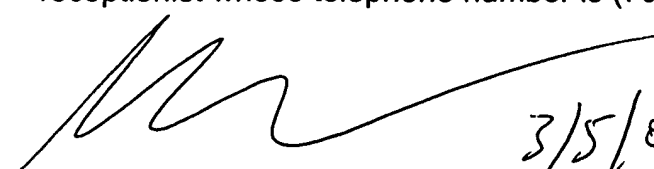
10. **THIS ACTION IS MADE FINAL.** Applicant's amendment necessitated additional grounds of rejection.

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11. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

DR. GEOFFREY R. AKERS, P.E.  
PRIMARY EXAMINER



3/5/04